THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the board.

Paper No. 43

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

RUBEN H. MANZO, DANIEL A. ALLEMANDI
and JORGE D. PEREZ

Junior Party,

v.

KAZUMI OGATA, YUUICHI ISOWAKI, HIDETOSHI NAKAO
and SHUUICHI NISHIHATA

Senior Party.

Patent Interference No. 103,749

Before: FRANKFORT, Administrative Patent Judge, and McKELVEY, Senior Administrative Patent Judge, and NASE Administrative Patent Judge.

McKELVEY, Senior Administrative Patent Judge.

ORDER ENTERING JUDGMENT AGAINST MANZO et al.

A. Background

The interference was declared on November 4, 1996, upon entry of a NOTICE DECLARING INTERFERENCE (Paper No. 1). Thereafter, on November 6, 1996, an ORDER (Paper No. 2) was entered suggesting that the Ogata application involved in the interference may be abandoned. Ogata was given a period of time to express his views on the issue of abandonment. Ultimately, a merits panel of the board entered an order holding that the Ogata application had become abandoned. MEMORANDUM OPINION AND ORDER (Paper No. 25) entered January 22, 1997.

In response to the ORDER, Ogata had filed a petition to revive the Ogata application contingent on the board concluding that the application had become abandoned. On January 22, 1997, an order was entered in the Office of the Assistant Commissioner for Patents granting Ogata's petition to revive (Paper No. 26).

On January 22, 1997, an ORDER REDECLARING INTERFERENCE (Paper No. 27) was entered. Pursuant to the ORDER REDECLARING INTERFERENCE, the interference was declared on the same terms as those set out in the NOTICE DECLARING INTERFERENCE (Paper No. 1).

A time was set for filing preliminary statements. Manzo, the junior party, did not file a preliminary statement. Rather, Manzo filed a COMMUNICATION (Paper No. 38) in which the following appears:

> No responses are being made to any of the papers that were filed in the above interference, because it is patentees Manzo et al's position

that the Ogata et al application stands abandoned for more than one year.

In view of the fact that Manzo did not file a preliminary statement, an ORDER TO SHOW CAUSE (Paper No. 39) requiring Manzo to state why judgment should not be entered against him was entered on June 6, 1997 (Paper No. 39). Manzo timely filed MANZO ET AL.'S RESPONSE TO ORDER TO SHOW CAUSE (Paper No. 40). According to Manzo's response, the interference was not properly declared given the abandoned status of the Ogata application on November 6, 1996, the day the interference was declared. Manzo also argues that the Ogata application is still abandoned, notwithstanding the granting of Ogata's petition to revive. Manzo bottoms his argument on the fact that Ogata did not submit with the petition to revive "responsive pleading or [required] fees ***" (Paper No. 40, page 2).

Ogata timely filed OGATA OPPOSITION TO MANZO RESPONSE TO ORDER TO SHOW CAUSE (Paper No. 42). Ogata notes that Manzo did not file a preliminary motion for judgment (37 CFR § 1.633(a)) based on alleged abandonment. Hence, Ogata reasons that Manzo did not properly raise the "abandonment" issue and that the board should not consider that issue. Alternatively, and on the merits, Ogata points out that no amendment was needed with the petition to revive inasmuch as the Primary Examiner had entered an Examiner's Amendment. Following entry of the Examiner's Amendment, there were no longer any unresolved rejections and/or

objections. Hence, according to Ogata, an amendment did not need to accompany the Ogata petition to revive. Lastly, Ogata noted that the required fee had been authorized to be charged to a PTO deposit account (page 2 of Paper No. 14 in the file of application 08/193,589). We note that the fee was charged by the PTO to that deposit account. Id. at page 1.

B. Discussion

Ogata maintains that Manzo did not raise the "abandonment" issue properly. Whether the issue was raised properly or not is not particularly important. The fact is Manzo is wrong on the merits, because the Ogata application is pending and is not abandoned.

We disagree with Manzo's abandonment argument on the merits. On this record, it turns out that the Ogata application was abandoned on the date the NOTICE DECLARING INTERFERENCE was entered. Hence, we can agree for purposes of discussion that the board may have lacked jurisdiction to declare the interference on November 4, 1996. However, following revival of the Ogata application by the Office of the Assistant Commissioner for Patents and entry of the ORDER REDECLARING INTERFERENCE, the board acquired subject matter jurisdiction over the interference.

Manzo's argument that the petition to revive should not have been granted because Ogata did not file "responsive pleadings" or a fee with the petition to revive is without merit. It is true

that a response ordinarily must accompany a petition to revive, unless, of course, it has been previously filed. 37 CFR § 1.137(b)(1). A response had previously been filed (Paper No. 11 in the file of application 08/193,589). The need for a further response was overtaken by the event of the entry of the Examiner's Amendment. Plainly, the previously filed response, in combination with the Examiner's Amendment, demonstrate that "responsive pleadings"--to use Manzo's words--had previously been filed. Hence, there no longer was a need to file a response with the petition to revive. It has long been jurisprudence in our country that an individual need not do something which would be futile or impossible. Since the Primary Examiner had entered an Examiner's Amendment which overcame all rejections and objections, there was nothing more for Ogata to do. In short, it would have been impossible for Ogata to have filed any response which would have made sense. Furthermore, the fact that the Office of the Assistant Commissioner accepted the petition to revive and acted favorably on its merits without a response, adequately demonstrates that the Office of the Assistant Commissioner for Patent also felt that no further response was necessary.

Since Manzo has failed to overcome the order to show cause, judgment will be entered against him.

C. Judgment

Upon consideration of the record, and for the reasons given, it is

ORDERED that judgment on priority as to Count 1, the only count in the interference, is awarded against junior party Ruben H. Manzo, Daniel A. Allemandi, and Jorge D. Perez.

FURTHER ORDERED that judgment on priority as to Count 1, the only count in the interference, is awarded in favor of senior party Kazumi Ogata, Yuuichi Isowaki, Hidetoshi Nakao, and Shuuichi Nishihata.

FURTHER ORDERED that the junior party Ruben H. Manzo, Daniel A. Allemandi, and Jorge D. Perez is not entitled to a patent containing claims 1-2 (corresponding to Count 1) of U.S. Patent Nº 5,395,936, granted March 7, 1995, based on application 08/071,638.

FURTHER ORDERED that, on this record, the senior party Kazumi Ogata, Yuuichi Isowaki, Hidetoshi Nakao, and Shuuichi Nishihata is entitled to a patent containing claims 1-3, 9, 19-20, 22-23 and 26 (corresponding to Count 1) of application 08/193,589, filed February 8, 1994.

CHARLES E. FRANKFORT, Administrative Patent Judge	)
FRED E. McKELVEY, Senior Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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